

Remarks:

Applicant has read and considered the Office Action dated July 12, 2004. Claims 1, 3 and 4 are amended, and claim 2 cancelled. Claims 1 and 3 to 11 are pending.

Applicant has amended claim 1 to define R^2 as “a square of the correlation coefficient between a reference value set and said predicted set of analyte levels”, support for the amendment can be found, for example, at page 12, lines 10 to 11. Furthermore, the features of claim 2 have been incorporated into claim 1, step (d), and claim 2 cancelled without prejudice or disclaimer. Step (d) of claim has also been amended as follows:

- to read as a Markush group consisting of two steps (d)(1) and (d)(2). Support for the amendment can be found, for example, from page 12, line 15, to page 13, line 16.

- by changing step (i) of claim 2 (now step (d)(2) of claim 1) from “selecting the predicted sets,” into a “wherein” clause. Support for the amendment can be found, for example, from page 12, lines 15 to 31.

- the phrase “calculating a suitability score in response to the slope,” in step (ii) of claim 2 (now step (d)(1) of claim 1) has been amended to “calculating a suitability score according to the slope,”. Support for the amendment can be found, for example, at page 12, line 24.

- the phrase “predicted set having the optimal (highest) suitability,” in step (ii) of claim 2 (now step (d)(2) of claim 1) has been amended to “predicted set having the highest suitability,”. Support for the amendment can be found, for example, at page 12, line 29.

- the phrase “if no predicted sets,” in step (iii) of claim 2 (now step (d)(2) of claim 1) from has been into a “wherein” clause. Support for the amendment can be found, for example, from page 13, lines 5 to 9.

Applicant has included step (v) of claim 2 as step (e) of claim 1, and amended the term “determining” to “declaring”, support for the amendment can be found, for example, from page 13, lines 5 to 9.

Claims 3 and 4 have been amended to depend from claim 1.

Rejection under 35 U.S.C. 103

Claims 1, 7-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenthal (US Patent No. 5,576,544, hereinafter referred as Rosenthal) and in view of Small et al (Anal. Chem. (1993) 65, 3279-3289, hereinafter referred as Small). Applicant respectfully disagrees.

Examiner states that Rosenthal teaches “providing a plurality of calibration algorithms” at column 2, lines 63 to 65; and “ selecting an appropriate calibration algorithm by using a suitability score [...]” at column 6.

Rosenthal teaches two aspects of calibrating a near-infrared analysis instrument. The second aspect, starting at column 2, line 63, states that “a multiple calibration method [is] used to provide additional accuracy in blood analyte measurements.” The multiple calibration method is described (starting col 2, line 66) as:

applying a near-infrared optical measurement to a first calibration which calibrates the optical measurement over substantially the entire range of possible blood analyte concentrations and produces a first calibrated value. Further, the first calibration determines whether the first calibrated value falls into a first higher range or a first lower range of possible blood analyte concentrations. A higher range calibration is selected for the first higher range and which calibrates the first calibrated value over the higher range. A lower range calibration is also selected for the first lower range and calibrates the first calibrated signal over the

lower range. Based on which range the first calibrated value falls within, an appropriate second calibration is applied to provide a highly accurate measurement of blood analyte concentration.

Rosenthal does not teach or suggest that a different algorithm is selected from a plurality of algorithms for use in the first and the second calibration. It would be apparent to a person skilled in the art that Rosenthal teaches a multiple step method, and that the same algorithm used in the first calibration can be used to calibrate both the higher range and the lower range in the second calibration.

In contrast, the present invention, as recited in the amended claims, is directed to a method of calibrating a spectroscopic device by selecting an algorithm from a plurality of calibration algorithms generated by a generally independent process (page 11, line 19). The plurality of the algorithms is generated, as described from page 9, lines 4 to page 10, line 17, by combining calibration-suitable data sets.

Hence, Applicant submits that one skilled in the art, in view of Rosenthal and Small, which teaches a multi-step method and the variability range, slope and R^2 , respectively, would not have the motivation to generate a plurality of algorithms by combining the calibration-suitable data sets, and select an algorithm based on the suitability score as described by the present invention. There is no suggestion, inspiration, or motivation in the cited art that the references should be combined to reconstruct the claimed invention. Absent some incentive or suggestion in the prior art to support the combination, obviousness is not established. AIR-Vend Inc. v. Thorne Industries, Inc. 625 F.Supp. 1123, 229 U.S.P.Q. 505, 515 (D.Minn. 1985), aff'd 831 F.2d 306 (Fed. Cir. 1987). Furthermore, it is improper to use Applicant's claims as a road map to combine references for a rejection. Grain Processing Corp. v. American maize-Products Corp., 840 F.2d 902, 907, 5. U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

However, for the sole purpose of expediting the prosecution of the present application,

Applicant has incorporated the features of claim 2, which was stated to be allowable if rewritten in independent form, into step (d) of the amended claim 1.

Claims 3 to 11 are now dependent on claim 1 and include the features of the independent claim and they therefore are also patentably inventive over Rosenthal in view of Small. Therefore, removal of the rejection to claims 1, and 7-11 under 35 U.S.C. 103(a) is requested.

Claims 2-6 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for the indication of allowable subject matter. As stated above, claim 1 has been rewritten in recite elements of claim 2 and is therefore believed to be in condition for allowance.

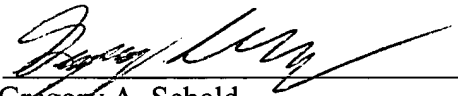
Applicant respectfully requests reconsideration of this application, based on the foregoing amendments and remarks. A speedy and favorable action on the merits is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.



Respectfully submitted,

MERCHANT & GOULD P.C.

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